

Appl. No. : 09/669,869
Filed : September 22, 2000

REMARKS

In response to the Office Action mailed August 2, 2005, Applicants respectfully request the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following remarks.

Recapture Rejection is Resolved

The Examiner rejected Claims 13 and 16-53 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the parent application. A recapture rejection was first made in this application in the Office Action mailed July 16, 2002, and was resolved by amendments made by Applicants in the Amendment filed December 13, 2002. Nevertheless, the Examiner has identified certain text that Applicants added during prosecution of Claims 1 and 5 of the parent '369 patent upon which to base the present recapture rejection.

Recapture Does Not Apply At Least to Method Claims 29-35 and 46-53

Claims 29-35 and 46-53 were included in the Examiner's recapture rejection. However, these claims are method claims, and no method claims were presented in the original '369 patent. These method claims are a different class of claims than those prosecuted in the '369 patent; they are comparable to neither Claim 1 nor Claim 5 of the '369 patent, and thus the recapture rule doesn't apply. Such treatment is consistent with the treatment of process claims and article of manufacture claims. (See M.P.E.P. §1412.02 (II) and (III)).

Claims 13, 22 and 36, As Amended, Do Not Recapture Surrendered Subject Matter

Independent Claims 13, 22 and 36 have been amended. In their current form, they do not recapture subject matter surrendered during prosecution of the '369 patent. For purposes of discussing and analyzing these claims in light of the Examiner's rejection, Applicants will compare these claims to the limitations added during prosecution of Claim 5 and identified by the Examiner as limitations A-D on Page 3 of the Office Action.

Text "A" as identified by the Examiner

The Examiner identified the text "integrally formed roller skate chassis . . ." as a limitation added to Claim 5 during prosecution. In fact, only "integrally formed" was added to Claim 5, and only this phrase is relevant for analysis purposes.

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Applicants first note that in order to overcome the recapture rejection, Applicants need not add the exact text “integrally formed” to the claims. As clearly stated in the M.P.E.P.:

[I]f the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. (M.P.E.P. § 1412.02 (I)(C) (emphasis added))

Independent Claims 13 and 36 now recite “A roller skate chassis assembly interconnected as a unit for attachment to . . .”. Independent Claim 22’s assembly is “integrated as a unit”. These limitations are another form of the “integrally formed roller skate chassis assembly” found in Claim 5, and are narrower than the original “A roller skate chassis assembly”.

Since the relevant limitation currently added to each of Claims 13, 22 and 36 is simply another form of the limitation added to Claim 5 during original prosecution, these claims must not be rejected under the recapture doctrine. Accordingly, Applicants contend that this portion of the Examiner’s rejection has been overcome.

Text “B” as identified by the Examiner

The Examiner identified the text “laterally spaced longitudinal members having upper edges integrally attached to said heel and forefoot members . . . longitudinal members having upper and lower generally planar portions” as a limitation added to Claim 5. In fact, the only text actually added was “laterally spaced”, “having upper edges integrally”, and “generally planar”. For simplicity, these phrases will be discussed in turn.

“laterally spaced”

Claims 13 and 36 already recite support members that are “laterally spaced”, and Claim 22 already recites left and right chassis members that are “spaced apart from each other”. Accordingly, Applicants submit that a form of this limitation is already included in the claims, and recapture clearly does not apply.

“having upper edges integrally”

Claim 13 already recites upper portions in the forefoot and heel sections, which upper portions each have an “upper edge, and a mounting flange extends from each upper edge”. This limitation may be a broader form of the limitation “having upper edges integrally”, but is

certainly narrower than the original Claim 5 text “members attached . . .”. Accordingly, there is no recapture in connection with this limitation.

Claim 22 has been amended, and now recites front and rear upper portions, “a forefoot mount defined above and supportingly connected to the front upper portions . . .” and “a heel mount defined above and supportingly connected to the back upper portions . . .”. These limitations are broader in form than the limitation “having upper edges integrally”, but is certainly narrower than the original Claim 5 text “members attached . . .”. Accordingly, there is no recapture in connection with this limitation.

Claim 36, like Claim 13, also already recites upper portions in the forefoot and heel sections, which upper portions each have an “upper edge, and a mounting flange extending from each upper edge”. This limitation may be a broader form of the limitation “having upper edges integrally”, but is certainly narrower than the original Claim 5 text “members attached . . .”. Accordingly, there is no recapture in connection with this limitation.

“generally planar”

Claim 13 already includes the limitations “each support member having a substantially planar lower portion” and “the upper portions lie in substantially convergent planes”. As such, recapture doesn’t apply with regard to this limitation of Claim 5.

Claim 22 already includes the limitations that “left and right lower portions lie in substantially parallel planes” and “a substantially planar upper portion in the front region and a substantially planar upper portion in the back region”. Recapture doesn’t apply with regard to this limitation of Claim 5.

Claim 36 recites “each support member having a substantially planar lower portion”. Claim 36 also has been amended, and currently recites “an upper portion in the heel section of each support member, at least part of each upper portion lying in a plane that is inclined relative to the lower portion”. This limitation is broader in form than the limitation “upper and lower generally planar portions”, but is certainly narrower than the original Claim 5 text “upper and lower portions”. Accordingly, there is no recapture in connection with this limitation of Claim 5.

Text “C” as identified by the Examiner

The text “and attached thereto” added to Claim 5 related to the one or more web members extending between said longitudinal members of Claim 5. Each of the independent Claims

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already includes a form of this limitation. Specifically, Claim 13 recites “one or more web members extending between and attached to the lower portions of the support members”; Claim 22 recites “the chassis members and one or more web members are integrally attached to one another”; and Claim 36 recites “at least one web member extending between and attached to the support members”.

Again, each of these limitations may have a different form than the exact text added to original Claim 5, but is certainly narrower than the original Claim 5. Accordingly, there is no recapture in connection with this text.

Text “D” as identified by the Examiner

The Examiner identified the text “convergent planes in an upwardly extending direction” as a limitation added to Claim 5. In fact, the text actually added was “in an upwardly direction above said one or more web members”. Claims 13, 22 and 36 in their current forms avoid recapture in connection with addition of this limitation of Claim 5.

Claim 13 includes the limitation “the upper portions lie in substantially convergent planes in an upwardly extending direction above said one or more web members.” This limitation clearly avoids recapture.

Claim 22 includes the limitations “the upper portions being positioned substantially above the one or more web members” and “wherein at least one of the upper portions of each of the chassis members lies in a plane that is inclined relative to the adjacent planar lower portion and is convergent in an upward direction with the corresponding planar upper portion of the spaced apart chassis member.” This limitation also clearly avoids recapture.

Claim 36 has been amended, and now recites “an upper portion in the heel section of each support member, at least part of each upper portion lying in a plane that is inclined relative to the lower portion, the upper portion planes being convergent in an upwardly direction above the at least one web member, the upper portion extending upwardly from the lower portion . . .”. This limitation, though in a somewhat broader form in some respects than the limitations added to Claim 5, is narrower than original Claim 5 in this respect, and thus avoids recapture.

As discussed above, amended independent Claims 13, 22 and 36 avoid recapture. As such, Applicants respectfully request that the Examiner withdraw the rejection of these claims.

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Further, Claims 16-21, 23-28, and 37-45 depend from these independent claims, and recite additional patentable subject matter. Such dependent claims are clearly not subject to recapture, and these claims are also in condition for allowance.

Reissue Oath/Declaration Sufficiently Sets Forth Error to be Corrected

The Examiner contends that the reissue oath/declaration is defective, and that the error to be corrected by reissue is not recited well enough. Specifically, the Examiner states that “it needs to be clearly set forth what claim language and elements are unnecessary to practice the invention and which were irrelevant to allowance of the resulting patent.” (Office Action, page 2). The Examiner has thus rejected all of the pending claims as based upon a defective reissue declaration.

Applicants respectfully disagree with the Examiner’s objection, and traverse the rejection. Regarding Reissue Declarations, the M.P.E.P. clarifies:

Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error this requirement of a reissue oath/declaration is satisfied. (M.P.E.P. §1414 (II)(B)(emphasis added))

The M.P.E.P. goes on to state:

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and how it renders the original patent wholly or partly inoperative or invalid. (M.P.E.P. §1414 (II)(B)(emphasis added))

In paragraph 5 of the Reissue Declaration filed by Applicants on April 26, 2001, Applicants state that “the ‘369 patent is partially inoperable by claiming less than we had a right to claim.” Paragraph 6 then specifically points out language in the added reissue Claim 13 that is broader than that of the issued ‘369 patent Claim 5, and even compares it to the narrower language of the issued claim. For example, Applicants point out that issued Claim 5 requires “The upper portions form substantially convergent planes in an upwardly extending direction above the one or more web member.” Applicants identify this narrow language as error when they state, “Further, the language that ‘in at least one of the heel and forefoot sections, the upper

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portions lie in substantially convergent planes,' [of reissue Claim 13] is broader than the language of original Claim 5."

Applicants have thus satisfied the requirement to identify one error upon which the reissue is based, and how the error makes the patent partially inoperative by claiming less than Applicants had a right to claim. This reason for inoperativeness is clearly appropriate (see M.P.E.P. §1414).

Applicants identified other errors in the declaration. However, since it is clear that Applicants satisfied their burden of identifying at least one error, further discussion is not warranted.

Since Applicants Reissue oath/declaration filed on April 26, 2001 satisfied Applicants' burden of identifying at least one error to be corrected by reissue, Applicants respectfully request that the Examiner withdraw the rejection of the claims as being based upon a defective reissue declaration.

Notwithstanding the above discussion, Applicants recognize that, because certain amendments were made to the claims in this paper, a supplemental reissue oath/declaration may be necessary before the claims are allowed. However, the scope of such supplemental reissue oath/declaration will be limited to a statement that errors corrected and/or amendments made since the time of the prior declaration were aroused without any deceptive intent on the part of the applicant, and Applicants wish to make sure the issues concerning the claims are fully resolved before obtaining another supplemental declaration.